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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/528,036	12/02/2005	Craig A. Andreiko	ORM-231US	2750
26875 7590 10/21/2009 WOOD, HERRON & EVANS, LLP 2700 CAREW TOWER 441 VINE STREET CINCINNATI, OH 45202			EXAMINER EIDE, HEIDI MARIE	
			ART UNIT 3732	PAPER NUMBER
			MAIL DATE 10/21/2009	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/528,036	Applicant(s) ANDREIKO, CRAIG A.	
	Examiner HEIDI M. EIDE	Art Unit 3732	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 August 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 26-28 and 45-51 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 26-28 and 45-51 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 31 August 2009 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on August 31, 2009 has been entered.

Drawings

The drawings were received on August 31, 2009. These drawings are accepted

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Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 26-28 and 45-51 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sachdeva et al. 6,315,553 (Sachdeva) in view of DeBusk et al. 5,991,728 (DeBusk).

2. Sachdeva teaches a method of providing a custom orthodontic appliance for treatment of a patient, the method comprising receiving information from an orthodontic practitioner for providing a custom orthodontic appliance for a patient in response to the

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information from the orthodontic practitioner (col. 10, ll. 45-52), maintaining a database, accessible by a computer, storing in the database information identifying information relating to treatment plan options including information about prescriptions (col. 5, ll. 46-67), determining parameters for the configuration of a custom orthodontic appliance for the patient and providing to the orthodontic practitioner an orthodontic appliance design for the patient having a configuration that includes the determined parameters (col. 4, ll. 18-39). Sachdeva does not teach the method comprising maintaining a database containing data related to each of a plurality of practitioners and information identifying the practitioners and information relating to treatment plan options including preferences as to orthodontic associated with the respective practitioners.

3. DeBusk teaches the method comprising maintaining a database accessible by computer and containing data related to each of a plurality of practitioners, storing in the database, information identifying the practitioners and information relating to treatment plan options including default preferences associated with the respective practitioners (col. 15, ll. 1-30). It would have been obvious to one having ordinary skill in the art at the time of the invention to modify Sachdeva with the database containing a plurality of practitioners as a matter of obvious design choice since of the court held that mere duplication of parts has no patentable significance unless a new and unexpected result is produced (*In re Harza*, 274 F.2d 669, 124 USPQ 378 (CCPA 1960), MPEP 2144.04).

4. Sachdeva teaches the method further comprising receiving information from the orthodontic practitioner of a treatment plan option for treatment of the patient and determining at least one of the parameter based at least in part on the information of the

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treatment plan option received from the orthodontic practitioner (col. 15, ll. 34-37), the method further comprising receiving information from the orthodontic practitioner of a treatment plan option for treatment of the patient and determining parameter addressed by the information of the treatment plan option received from the orthodontic practitioner in accordance with that information and determining parameters not so addressed in accordance with information stored in the database (col. 10, ll. 26-24) and the method further comprising providing to the orthodontic practitioner the orthodontic appliance manufactured in accordance with the orthodontic appliance design (col. 4, ll. 31-39).

5. As to claim 46, Sachdeva teaches a method of providing a custom orthodontic appliance for treatment of a patient, the method comprising in response to information from an orthodontic practitioner (col. 10, ll. 27-34), providing an orthodontic appliance for an individual patient having a configuration that includes appliance parameters base at least in part on predetermined treatment plan options including information about prescriptions associated with the practitioner (col. 10, ll. 45-52). Sachdeva does not teach the treatment retrieved from a previously created and maintained database containing database containing data associating a plurality of orthodontic practitioners with treatment plan options including default preferences as to one or both of orthodontic prescriptions and orthodontic appliance hardware respectably preferred by each practitioner.

6. DeBusk teaches the method comprising maintaining a database accessible by computer and containing data related to each of a plurality of practitioners, storing in the database, information identifying the practitioners and information relating to treatment

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plan options including default preferences associated with the respective practitioners (col. 15, ll. 1-30). It would have been obvious to one having ordinary skill in the art at the time of the invention to modify Sachdeva with the database containing a plurality of practitioners as a matter of obvious design choice since of the court held that mere duplication of parts has no patentable significance unless a new and unexpected result is produced (*In re Harza*, 274 F.2d 669, 124 USPQ 378 (CCPA 1960), MPEP 2144.04).

7. Regarding claim 47, Sachdeva teaches a method of providing a custom orthodontic appliance to an orthodontic practitioner for treatment of an individual patient, the method comprising in response to a request from an orthodontic practitioner to a custom orthodontic appliance for orthodontic treatment of an individual patient, providing to the orthodontic practitioner a custom orthodontic appliance for orthodontic treatment of the individual patient design in part based on patient-specific information associated with the request and in part based on default information of treatment preference associated with the requesting orthodontic practitioner and retrieved from a database containing previously stored default information data including information about prescriptions (col. 4, ll. 18-39, col. 5, ll. 46-67, col. 10, ll. 45-52). Sachdeva does not teach the database containing previously stored default information data associating each of a plurality of orthodontic practitioners with treatment preferences, including default preference as to one or both of orthodontic prescriptions and orthodontic appliances, to be applied unless otherwise instructed by a requesting orthodontic practitioner.

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8. DeBusk teaches the method comprising maintaining a database accessible by computer and containing data related to each of a plurality of practitioners, storing in the database, information identifying the practitioners and information relating to treatment plan options including default preferences associated with the respective practitioners (col. 15, ll. 1-30). It would have been obvious to one having ordinary skill in the art at the time of the invention to modify Sachdeva with the database containing a plurality of practitioners as a matter of obvious design choice since of the court held that mere duplication of parts has no patentable significance unless a new and unexpected result is produced (*In re Harza*, 274 F.2d 669, 124 USPQ 378 (CCPA 1960), MPEP 2144.04).

9. Sachdeva further teaches the method further comprising designing and manufacturing the custom orthodontic appliance for the individual patient based on the patient specific information and the default information (col. 5, ll. 46-67, col. 7, ll. 9-12, 23-27), the method further comprising designing the custom orthodontic appliance based in part on patient information relating to the individual patient that had been previously stored in a patient-information database containing patient information relating to a plurality of individual patients (col. 5, ll. 45-67) and the method wherein the patient information relating to the plurality of individual patients includes information relating to patient anatomy (col. 5, ll. 46-50).

10. Sachdeva does not teach the method further comprising creating a database including the default information of treatment preferences from each of the plurality of orthodontic practitioners.

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11. DeBusk teaches the method further comprising collecting, for storage in the database, the default information of treatment preferences from each of the plurality of practitioners (col. 9, ll. 13-19, col. 10, ll. 30-58). It would have been obvious to one having ordinary skill in the art at the time of the invention to modify Sachdeva with the database containing a plurality of practitioners as a matter of obvious design choice since of the court held that mere duplication of parts has no patentable significance unless a new and unexpected result is produced (*In re Harza*, 274 F.2d 669, 124 USPQ 378 (CCPA 1960), MPEP 2144.04).

Response to Arguments

12. Applicant's arguments filed August 31, 2009 have been fully considered but they are not persuasive. Applicant argues that the secondary reference DeBusk does not teach the limitations of a database containing information identifying a plurality of practitioners and information relating to treatment plan options including preferences as to orthodontic prescriptions. However, the primary reference teaches the database containing information relating to treatment plan options including preferences as to orthodontic prescriptions as discussed above in the rejection. DeBusk is used to teach the limitation of a database containing information, including treatment plan options and preferences, about a plurality of practitioners. As discussed above, it would have been a matter of obvious design choice to include a plurality of practitioners and information relating to each one, to the database taught by Sachdeva since the court held that mere duplication of parts has no patentable significance unless a new and unexpected result is produced (*In re Harza*, 274 F.2d 669, 124 USPQ 378 (CCPA 1960), MPEP 2144.04).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to HEIDI M. EIDE whose telephone number is (571)270-3081. The examiner can normally be reached on Mon-Thurs.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cris Rodriguez can be reached on 571-272-4964. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Heidi Eide
Examiner
Art Unit 3732

/Heidi M Eide/
Examiner, Art Unit 3732

10/20/2009

/Cris L. Rodriguez/
Supervisory Patent Examiner, Art Unit 3732